

## REMARKS

Reconsideration of the present application is respectfully requested. Claims 1, 5-26 and 28-30 remain pending. No claims have been amended, canceled or added in this response.

Claims 14-19 stand rejected under 35 U.S.C. § 102(b) based on Ellipsus White Paper -- InfiniteMAP™ ("Ellipsus"). Claims 1, 5, 6, 9, 10 and 23-30 stand rejected under 35 U.S.C. § 103(a) based on Ellipsus. Claims 1-30 stand provisionally rejected for obviousness-type double patenting based on co-pending U.S. patent application 10/600,746.

### Double-Patenting Rejection

Applicants acknowledge the provisional obviousness-type double patenting rejection. Since this type of rejection can be overcome by terminal disclaimer, Applicants respectfully request that this rejection be held in abeyance until the present application is found to be otherwise in condition for allowance.

### Request for Additional Information

In the initial Office Action (mailed 6/28/2005) the Examiner requested "any additional information that Applicants may have access to that would be material to the examination of this Application." Applicants responded, in their amendment filed on 9/30/2005, that Applicants were not aware of any other information that may be material to the examination of this application, other than the materials which have already been cited and the materials which are being cited concurrently with the filing of this

amendment. During the preparation of this response, however, it occurred to Applicants that there are facts, of which the Examiner might not be aware, which the Examiner might consider to be relevant. Applicants' failure to disclose these facts earlier was an oversight, not an intentional omission.

In particular, Applicants would like to point out that the cited Ellipsus reference relates to a company, Ellipsus Systems, Inc., which was acquired by the assignee of the present application, Openwave Systems Inc., prior to the filing of the present application. At least one of the co-inventors of the present application was a founder and employee of Ellipsus Systems, Inc. prior to that acquisition. Moreover, it is believed that said at least one of the co-inventors is/are the author(s) of the cited Ellipsus reference and is/are also inventor(s) of the subject matter disclosed in it (said individuals are no longer employees of Openwave Systems, however, and cannot easily be reached to confirm the authorship issue). As such, Applicants are thoroughly familiar with the product disclosed in the Ellipsus reference and are more-than-qualified to comment on the extent of that reference's disclosure.

The present invention, as claimed, was created as part of the development of an improved/updated version of the product disclosed in the Ellipsus reference. As discussed further below, Applicants emphatically submit that the Ellipsus reference does **not** disclose or suggest the present invention, as claimed.

#### Prior Art Rejections

Applicants respectfully traverse the prior art rejections. Applicants maintain their previously-submitted arguments (see Amendment filed on 9/30/05, pp. 12-16), which

are incorporated herein by reference in their entirety, and further traverse for the additional reasons explicitly stated herein.

In addition, Applicants will now respond directly to the Examiner's response to Applicants' initial arguments. On page 13 of the Final Office Action the Examiner responds to Applicants' previous arguments, rejecting Applicants' arguments essentially based on the form of those arguments rather than the substance (the Examiner did not respond on the merits). As will now be explained, the Examiner's position is erroneous.

In paragraph 13 of the Final Office Action, the Examiner states, "Applicants arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention **without specifically pointing out how the language of the claims patentably distinguishes them from the references**" (emphasis added). However, in the very next sentence (in paragraph 14), the Examiner contradicts herself by stating, "Applicant's first argument simply **recites the claim language and states that the art does not disclose or suggest the recited features**" (emphasis added). Thus, the Examiner's response in paragraph 13 is clearly inaccurate, by the Examiner's own admission. Applicants in fact clearly pointed out specific claim limitations that are not disclosed or suggested by the cited art.

In paragraph 14 the Examiner goes on to state, "There appears to be no indication as to **why** the cited reference and specifically the cited parts of the reference in the Office action do not disclose or suggest the recited language" (emphasis added). It appears that the Examiner misunderstands the law of anticipation and well-established PTO procedures for prior art rejections under 35 U.S.C. § 102. All that is

required to overcome a rejection under section 102 is for the applicant to point out one or more claim limitations that the cited reference fails to disclose, which Applicants have done. There is no requirement in the law or in PTO procedures that requires an applicant to explain “**why**” a cited reference fails to disclose or suggest the limitation in question, on order to overcome a rejection under section 102. ◦

Furthermore, where, as here, the Examiner only points to portions of disclosure in a cited reference which are far less detailed than the specific claim language in question (see initial Office Action, p. 6, regarding rejection of claim 6) and relies upon numerous assertions of inherency (discussed below), the applicant does not have the burden of explaining why the cited portion of disclosure does not include the detailed claim limitations in question. Rather, it is the Examiner who bears the burden of proving that the cited subject matter **does** include the claim limitations in question. Applicants have clearly met and surpassed their burden with regard to overcoming the rejection.

In paragraph 15 of the Final Office Action, the Examiner addresses Applicants argument about inherency by stating, "In addition, as to the inherency argument, Applicant simply states that each domain representing a different subset of the plurality of wireless services subscribers is not inherent, which the Examiner clearly disagrees with. However there is no additional argument by Applicant, except for a citation that defines inherency. Therefore, this argument is also simply a general allegation of patentability."

Applicants' argument, to which the Examiner refers, was as follows (previous amendment, p. 15):

"Inherency . . . may not be established by mere probabilities or possibilities. The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (emphasis added). Further, if the Examiner intends to rely upon extrinsic evidence to support a contention of inherency, the extrinsic evidence "must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by one of ordinary skill." *Continental Can Co.* at 1268.

Applicants do not see what sort of "additional argument" the Examiner thinks would be needed on this issue. Applicants' above-quoted argument (which Applicants maintain) is specific, complete and adequate to fully rebut the assertion of inherency. The point, if it was not initially clear, is that the Examiner's assertion of inherency is improper because it is (notwithstanding the Examiner's assertions to the contrary) entirely speculative, and furthermore, the assertion is simply incorrect. Applicants maintain that the claim limitations in question (i.e., relating to specific characteristics of "domains") are **not** inherent in the Ellipsus reference.

As mentioned above, it is believed that at least one of the co-inventors of the present application is the author of the cited Ellipsus reference and is an inventor of the technology disclosed in it. The present invention, as claimed, was created as part of the development of an improved/updated version of the product disclosed in the Ellipsus reference. Applicants are thoroughly familiar with the product described in the Ellipsus reference. Applicants submit, therefore, that the Examiner is not in a position to dispute Applicants' arguments regarding the Ellipsus reference, absent **clear evidence** which confirms the Examiner's assertion of inherency. Applicants again submit that the Examiner must either withdraw the rejection on this basis or support the assertion of

inherency with clear evidence that the claim limitations in question (regarding domains) are **necessarily present** in the subject matter disclosed in the Ellipsus reference.

For the reasons mentioned above and previously, therefore, all pending claims are believed to be patentable over the cited art.

#### Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

#### Conclusion


For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

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